III. REMARKS

Claims 1 and 20 are amended for clarification. No new matter is presented. Applicant has now had an opportunity to carefully consider the Examiner's comments set forth in the Final Office Action mailed June 15, 2006. Reconsideration of the application is respectfully requested.

The Office Action

Applicant has amended independent claims 1 and 20 to more clearly define the term "customized formatting". As suggested by the Examiner, this term refers to the original platform of the book file now described as "the digital structure and codes of the originating software, hardware, and operating system". Applicant submits that this amendment fully remedies the basis for the rejection based on 35USC112.

Claims 1-3, 9-22, and 28-38 stand rejected under 35USC102(e) on the basis of the cited reference Warmus et al, U.S. Patent No. 6,332,149.

This rejection is traversed for the following reason:

The cited reference Warmus, et al fails to disclose each and every limitation of the claims of this application. In particular claim 1 as amended states:

"**a) receiving as a complete book file, including a book   block,   a digital representation, with a digital structure   and   codes   of   an originating software, hardware, and   operating system , of a book targeted for reproduction;**

b) converting said complete book file to have a solution-independent, intermediate format, in a universal format,   devoid   of

said digital structure and codes of an originating software, hardware, and operating system;"

and claim 20 as amended states:

> **"a book file generator adapted to generate a digital representation with a digital structure and codes of an originating software, hardware, and operating system of a book targeted for reproduction, said representation being a complete book file, including a book block;**
>
> **a solution-independent converter adapted to convert said complete book file to have a solution-independent, intermediate format, in a universal format, devoid of said digital structure and codes of the originating software, hardware, and operating system;"**

The cited reference Warmus et al fails to disclose these claimed features.

the reference Warmus relates to the textual content of a book file while the system and method of this application relate to the digital format and structure, i.e. platform of a book file. The reference Warmus involves a PDL file. A PDL file is defined as follows:

> **"A page description language (PDL) specifies the arrangement of a printed page through commands from a computer that the printer carries out. Hewlett Packard's Printer Control Language (PCL) and Adobe's Postscript are the two most commonly used PDLs." (whatis.techtarget.com/)**

The use of PDL language indicates the page layout focus of the cited reference. In Warmus, the book is prepared as a template file divided into separate template pages for information that remains the same from one copy to the next and separate template pages for information that varies from one copy to the next. The PDL language enables the textual content flexibility to which the system of Warmus is directed. In the system of this application it is the overall digital platform that is manipulated to allow use of a book file on multiple printing systems.

In Warmus the fixed content portion of the template file of is maintained as a separate file "stripped" of the variable content, while the variable content portion of the template file is maintained as another separate file "stripped" of the fixed content. In the system of this application, the originating digital platform of the book file is converted. This is different than stripping the variable content of a file as in Warmus.

The problem to which Warmus is directed is a page file problem dealing with textual content and treats the textual files on a page by page basis, whereas the solution of the subject invention relates to digital platform of the entire book file. Warmus results in the customization of individual pages of a book during printing of multiple copies. In the system of this invention, all of the pages are processed in the same manner, with respect to content, while the entire book file may be transferred and converted to accommodate solution, or platform, or device dependent needs of a particular publisher.

The nature of the stripped working files of Warmus is explained at column 11, lines 10-29. There is no reference to changing digital structure and codes of an originating software, hardware, and operating system. The processing of the page files of Warmus causes an entirely different result than the processing of the book files in this application. Accordingly, the cited reference Warmus fails to disclose all of the limitations of the claims of this application.

Claims 4-8, and 23-27 stand rejected under 35USC103(a) based on the reference Warmus, in view of the cited reference Dickmeyer,et al, U.S. Patent No. 6,413,100. This rejection is traversed for the following reasons:

The reference Warmus does not render claims 4-8, and 23-27 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is

well established that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). As detailed above, claims 4-8, and 23-27, as dependent from either claim 1 or claim 20, all recite the conversion of the digital structure and codes of an originating software, hardware, and operating system, of a book targeted for reproduction. The reference Warmus fails to teach or suggest this feature.

Applicant submits that the above described deficiencies of the primary reference Warmus are not remedied by the proposed combination with the teaching of the reference Dickmeyer. The combined references do not therefore support a prima-facie case of obviousness. The modification of the teachings of Warmus or Dickmeyre, in order to obtain the invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art.
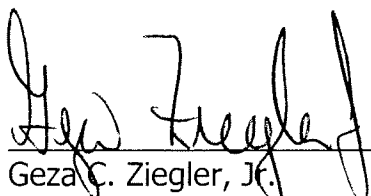
For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 24-0037.

Respectfully submitted,

Geza C. Ziegler, Jr.
Reg. No. 44,004

10 Nov 2006
Date

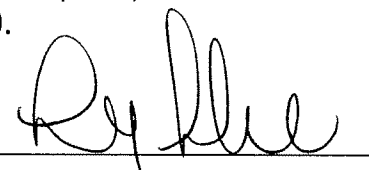Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

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